



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

J.W

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
|-----------------|-------------|----------------------|---------------------|

09/062,552 04/20/98 SHIRAIWA

Y 35.G2135

005514 LM31/0709
FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK NY 10112-3801

EXAMINER

FIELDS, D

ART UNIT

PAPER NUMBER

2722

DATE MAILED:

07/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/062,552

Applicant(s)
Shiraiwa

Examiner
Derrick Fields

Group Art Unit
2722



☒ Responsive to communication(s) filed on Apr 20, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-62 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-62 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2722

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 57 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 57, it is unclear to the examiner as to what the applicant means by "determination means for determining whether or not data *to instruct erasure of image data in the recorded data is present.*"

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Art Unit: 2722

4. Claims 1-55 and 57-62 are rejected under 35 U.S.C. 102(e) as being anticipated by **Shibaki et al. '368**.

Regarding claims 1, 47, 51, 57, 59, 61, and 62, Shibaki et al. discloses a memory medium for storing image data *comprising* a magnetic optical (MO) disk storage device **25** for storing document information (see col. 4, lines 65-67), image-reproduction instruction data for instructing whether or not the image data is to be reproduced so that the image-reproduction instruction data specifies an image for which image reproduction is instructed *comprising* a function of reading out the stored document information on an as-needed basis (see col. 1, lines 11-12), and that the specified image data can be selectively output based on the image reproduction instruction data *comprising* printing out the document information by means of a printer (col. 1, lines 12-13).

Regarding claims 2 and 4, Shibaki et al. discloses wherein memory medium also stores a program for controlling reproduction of the image data based on the image-reproduction instruction data and wherein the image-reproduction instruction data is provided for the name of each image data *comprising* a function of reading out the stored document information on an as-needed basis (see col. 1, lines 11-12).

Regarding claims 3 and 5, Shibaki et al. discloses wherein the image-reproduction instruction data is stored for each image data and wherein the image-reproduction instruction data comprises information for instructing image data to be reproduced stored in a specific file *comprising* printing identification information for specifying the document information stored in the storing medium (see col. 2, lines 22-23).

Art Unit: 2722

Regarding claims 6-8 and 39-42, Shibaki et al. disclose an image output control method comprising a function of recognizing mounting of a recording medium comprising a control panel unit for selecting a copy mode or a file mode (see col. 6, lines 57-59).

Regarding claims 9-26, Shibaki et al. disclose wherein said control function has a function of determining whether or not image-reproduction instruction data is stored in the medium, and wherein when it has been determined that image-reproduction instruction data is stored, said control function controls output so as to selectively output image data instructed by the image-reproduction instruction data comprising a function of reading out the stored document information on an as-needed basis and printing out the document information by means of a printer (see col. 1, lines 11-13).

Regarding claims 27, 29, 31, 33, 43, 45 and 49, Shibaki et al. disclose wherein a program for controlling reproduction of the image data based on the image-reproduction instruction data and wherein the image-reproduction instruction data is provided for the name of each image data *comprising* a function of reading out the stored document information on an as-needed basis (see col. 1, lines 11-12).

Regarding claims 28, 30, 32, 34, 44, 46, 48, and 50, Shibaki et al. disclose wherein the image-reproduction instruction data is stored for each image data and wherein the image-reproduction instruction data comprises information for instructing image data to be reproduced stored in a specific file *comprising* printing identification information for specifying the document information stored in the storing medium (see col. 2, lines 22-23).

Art Unit: 2722

Regarding claims 35 and 36, Shibaki et al. disclose wherein the output is executed by one of a hard copy output apparatuses *comprising* a printer 22 (see col. 4, line 61).

Regarding claims 37 and 38, Shibaki et al. disclose wherein the output is executed by a soft-copy output apparatus *comprising* a liquid crystal display section 61 (see col. 6, line 56).

Regarding claims 52, 55, and 60, Shibaki et al. disclose data display means for displaying image-output instruction data and image data, and data processing means for analyzing the image output instruction data *comprising* display section 61 and display control unit 70 (see col. 7, lines 24-25).

Regarding claims 53 and 54, Shibaki et al. disclose wherein said data display means displays a summary of data for specifying an image to be output *comprising* a parameter section 67 for setting various parameters relating to the copy mode (see col. 6, lines 55-64).

Regarding claim 58, Shibaki et al. disclose data editing means for editing data of the information recording medium *comprising* read and write operation of the optical disk (see col. 6, lines 5-14).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2722

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Shibaki et al. '368** in view of **Kurihara et al. '278**.

Regarding claim 56, Shibaki et al. disclose all of the limitations with respect to claim 55. However, Shibaki et al. do not disclose an alarm display when the number of prints to be output is larger than the number of outputtable prints. Kurihara et al. disclose an alarm displayed when memory data overflow signal is detected (see col. 3, lines 7-14 and 45-57). It would have been obvious to one of ordinary skill in the art at the time the invention was made to display an alarm when the memory is full and cannot obtain any data or prints to be outputted.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kato et al. '824, Tahara et al. '211, Nagata '957, Miura '307, and Nakamura et al. '134 are cited to further show the state of the art with respect to an image forming apparatus with means of storing image data on a diskette.

Art Unit: 2722

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick Fields whose telephone number is (703) 305-0573.

df

June 26, 1999



JOSEPH MANCUSO
P. M. V. S. A. 117